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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,095	12/29/2000	Stephan J. Jourdan	2207/7083	6387

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EXAMINER

ELLIS, RICHARD L

ART UNIT	PAPER NUMBER
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2183

DATE MAILED: 04/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/750,095

Applicant(s)

JOURDAN ET AL.

Examiner

Richard Ellis

Art Unit

2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-14 and 16-22 remain for examination.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.
3. Claims 1-14 and 16-22 are rejected under 35 USC 102(b) as being clearly anticipated by Yeager et al., U.S. Patent 5,758,112.
Yeager et al. was cited as a prior art reference in paper number 5, mailed December 9, 2003.
4. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, paper number 5, mailed December 9, 2003.
5. Applicant's arguments filed March 8, 2004, paper number 6, have been fully considered but they are not deemed to be persuasive.
6. In the remarks, applicant argues in substance:
 - 6.1. That: "Applicants' respectfully submit neither of the cited section disclose, teach or suggest "...an active list populated by a number of entries, the entries include an old file and a new field" as recited in claim 1. The Office Action asserts that the "new field" limitation of the equivalent [sic] of the logical destination registration [sic] number 256 of Yeager. However, this is not the case and the operation of the logical destination registration [sic] number 256 indicates so. Column 7 lines 40-44 of Yeager state: "Conversely, logical destination register number 256 is mapped to a physical destination register number held in integer free list 210, as shown by line 270, resulting in a physical register number 272 (Dest)". The function of the logical destination register number 256 in Yeager is functionally dissimilar to that of the new field in an embodiment of Applicants' invention. Support can be found at least at page 6 line 27, and page 7 line 24 of the Specification"

This is not found persuasive for numerous reasons. Firstly, it is noted that although applicant refers to support in the specification at page 6 line 27 and page 7 line 24, it is noted that applicant has failed to incorporate that support into the claim language itself.

"It is the **claims that measure the invention.**" *SRI Int'l v. Matshshita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc) (emphasis added).

"The invention disclosed in Hiniker's written description may be outstanding in its field, but the **name of the game is the claim.**" *In re Hiniker Co.*, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (emphasis added).

"limitations appearing in the specification will not be read into the claims, and ... interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper'." *Intervet Am.*,

v. Kee-Vet Labs., 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)(citation omitted).

"it is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim, ... this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By 'extraneous,' we mean a limitation read into a claim from the specification wholly apart from any need to interpret ... particular words or phrases in the claim." *In re Paulsen*, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (citation omitted).

Applicant's claims simply recite "an active list populated by a number of entries, the entries include an old field and a new field". This simply recites that there is a list containing entries. And that the entries include something labeled "old field" and something labeled "new field". That is all the claims recite. At best, the most definition that can be applied to "old field" and "new field" is that there is a time arrangement in that "old field" is some previous or prior value, and "new field" is some more recent value related to the claimed "old field".

Applicant is referred to the very section of Yeager et al. which he quoted in his arguments, which is reproduced below:

"Also, element 256 is designed in Yeager [sic] as a "logical destination registration [sic] number" and element 282 is designed as a "old physical destination"."

From this very section of applicant's own arguments, it is seen that Yeager et al. does indeed have a field which is indicated as "old" ("old physical destination" element 282) and is therefore exactly the claimed "old field". As well, from applicant's own arguments, it is seen that Yeager et al. also contains a field which is a more current version of the "old field" that being the "logical destination register number" (element 256) which is the more current version of the "field", making it exactly the claimed "new field".

Additionally, applicant is referred to the referenced portion of his own specification (page 7 line 24) where it states:

"New field 310 may contain the newly mapped physical register by the RAT 302 for each renamed instruction. For example, instruction 1 specifies logical register EAX as its destination physical register. RAT 302 evicts physical register R1 to old field 308 and maps logical register EAX for instruction 1 to physical register R2. This mapping is recorded in new field 310. As additional instructions are renamed, old field 308 and new field 310 record the evicted physical register and newly allocated, or mapped, physical register respectively."

This portion of the specification which was cited by applicant in the arguments clearly

indicates that the function in the specification of the claimed "new field" and "old field" is exactly the same as the function of Yeager et al.'s element 256 and element 282. In Yeager et al., element 282 holds the old physical register destination, which is exactly identical to the specifications stated function for "old field" ("old field 308 ... record[s] the evicted physical register") and for "new field" ("new field 310 record[s] ... [the] newly allocated ... physical register". So even if applicant were to amend the claims to include the cited specification definition of "old field" and "new field", Yeager et al. would continue to anticipate applicant's claims.

- 6.2. That: "These cited sections of the Yeager disclose [sic] the operation of the "redundant mapping tables", whose operation and function do not at all reflect the limitation of "setting said bit during a misprediction condition" as disclosed in Applicants' invention."

This is not found persuasive because as was pointed out to applicant in the last office action, the claimed "bit" is recited in Yeager et al. at (col. 15 line 61 to col. 16 line 14). Furthermore, setting of this bit is disclosed by Yeager et al. as pointed out in the last office action at col. 17 lines 26-50. The text of Yeager et al. at the cited portion of column 17 discusses the fact that the system makes copies of the tables for use in branch misprediction recovery. Accordingly, when the main tables are restored from the copies during branch misprediction recovery, the appropriate bits will be set as indicated by the copies. Accordingly, as was clearly pointed out in the last office action, Yeager et al. does indeed perform the minimal claim language of "setting the bit during a misprediction condition".

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE


ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Richard Ellis whose telephone number is (703) 305-9690. The Examiner can normally be reached on Monday through Thursday from 7am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eddie Chan, can be reached on (703) 305-9712. The fax phone number for the USPTO is: (703)872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Richard Ellis
April 7, 2004



RICHARD L. ELLIS
PRIMARY EXAMINER